

REMARKS/ARGUMENTS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 1 and 3-23 are presently pending in this case.

In the outstanding Official Action, Claims 1 and 3-23 were rejected under 35 U.S.C. §103(a) as unpatentable over Tohya et al. (U.S. Patent No. 4,636,703, hereinafter “Tohya”) in view of Patino et al. (U.S. Patent Application Publication No. 20050200331, hereinafter “Patino”).

The outstanding rejection is respectfully traversed.

Claims 1 and 11 recite a battery device comprising, *inter alia*:

a charging unit fixed inside the case; and  
***a battery side terminal disposed on the front surface of the case and connected to the battery through the charging unit, the battery side terminal configured to connect to a housing chamber side terminal of the electronic device to provide electric power to the charging unit from the electronic device as said charging unit charges and to provide electric power from the charging unit to the electronic device through the battery side terminal as the charging unit discharges, wherein a first engaging recessed part is formed on the front surface of the case of the battery device and a second engaging recessed part is formed on the front surface of the case of the battery device, the first and second engaging recessed parts being separated in the width direction by a gap.***

Tohya describes a charging apparatus including a cell accommodation frame structure 1 and a power supply casing 3 for charging batteries 101-104.<sup>1</sup> The frame structure 1 includes recesses 16 on opposite sides of the structure for a user to grab when plugging the device in and removing it from a power source.<sup>2</sup> The outstanding Office Action cited recesses 16 as “a first engaging recessed part” and “a second engaging recessed part,” a charging circuit within power supply casing 3 as “a charging unit,” and contact strips 13A,

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<sup>1</sup>See Tohya, abstract and Figures 1A and 4.

<sup>2</sup>See Tohya, column 4, line 15-19 and Figure 1A.

13B, 14A, 14B, 34A, 34B, 35A, 35B, 36A, and 36B of Tohya as “a battery side terminal.”<sup>3</sup> Further, the outstanding Office Action conceded that Tohya does not teach or suggest the above highlighted features, and provided two modifications to cure these deficiencies. First, the outstanding Office Action cited battery 122 of Patino being charged by charging unit 110 of Patino as describing “a battery side terminal” as recited in Claim 1.<sup>4</sup> Second, the outstanding Office Action asserted that it would have been obvious to move recesses 16 from the sides of structure 1 to “a front surface” as recited in Claim 1.<sup>5</sup> It is respectfully submitted that there is no suggestion or motivation to make either of these proposed modifications.

With respect to the first assertion, Tohya clearly describes that the device is used to charge cells, *not* discharge them.<sup>6</sup> In this regard, although contact strips 34A, 34B, 35A, and 35B of Tohya may be in contact with the charging circuit within power supply casing 3, the charging circuit within power supply casing 3 *never charges or discharges*, it simply passes on transformed and rectified power from power supply plug 32 to the contact strips.<sup>7</sup> Thus, it is respectfully submitted that modifying the charging circuit within power supply casing 3 of Tohya as suggested by the proposed combination would be a substantial redesign of the device described in Tohya. Such a modification is contrary to well settled case law which holds that if a proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

In this case, Tohya describes a standalone device for recharging batteries 101-104 when plugged into a wall outlet. The device of Tohya does not provide power through power supply plug 32, it only receives it from a wall outlet. Making the suggested modification to

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<sup>3</sup>See the outstanding Office Action at pages 2-3.

<sup>4</sup>See the outstanding Office Action at page 3.

<sup>5</sup>See the outstanding Office Action at pages 3-4.

<sup>6</sup>See Tohya, Summary of the Invention.

<sup>7</sup>See Tohya, column 5, lines 1-6.

include circuitry and structure to allow the device of Tohya to both recharge batteries and to deliver power would require a substantial reconstruction and redesign of the elements shown in Tohya, as well as change in the basic principle under which the Tohya construction was designed to operate. Therefore, there can be no suggestion or motivation to make such a combination. See MPEP §2143.01.

Further, it is unclear how the device of the proposed combination would deliver power through prongs 32. Applicant is unaware of any electronic device that receives power delivered from prongs such as prongs 32. If the present rejection is to be maintained, it is respectfully requested that an Advisory Action indicate what electronic device the proposed combination could provide power to the purpose of facilitating the appeals process.

In the Response to Arguments section of the outstanding Office Action, the assertion was made that “such a combination would be as simple as providing a housing with a power supply charging as taught by Tohya inside the charging circuit of Patino, and that does not require undue redesign.” However, it is respectfully noted that the outstanding rejection includes Tohya as the primary reference. According to the controlling case law, one evaluates whether the proposed modifications would be substantial redesigns of the primary reference or would make the primary reference unsuitable for its intended purpose. In the present case, as noted above, the proposed modification would be a substantial redesign of the primary reference which is only a battery charger. Accordingly, there is no suggestion or motivation to make the proposed modification.

With respect to the second assertion, recesses 16 are located on opposite side surfaces of structure 1 so that a person can grasp them when plugging in or removing the charging apparatus from a wall plug. Contact strips 13A, 13B, 14A, 14B, 34A, 34B, 35A, 35B, 36A, and 36B, asserted as “a battery side terminal,” are located *inside* of structure 1. Further, the front surface recited in Claim 1 on which the first and second engaging recessed parts is

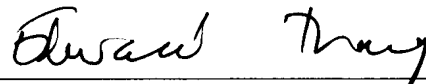
located is also a surface on which the battery side terminal is disposed. Accordingly, moving recesses 16 onto a same surface as any of the contact strips would prevent a user from placing their fingers in the recesses when plugging in or removing apparatus from a wall, making the recesses 16 useless. As this modification is also a substantial reconstruction and redesign of the device of Tohya and a change to the basic principle behind providing the recesses, it is again respectfully submitted that there is no suggestion or motivation to make such a modification. Further, this modification makes the recesses unsuitable for their intended purpose. Again, there can be no suggestion or motivation to make such a modification.

Thus, as there is no suggestion or motivation to make either of the modifications to create the proposed combination, Claims 1 and 11 (and Claims 3-10 and 12-23 dependent therefrom) are patentable over Tohya in view of Patino.

Accordingly, the pending claims are believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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